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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,708	05/14/2001	Takahiro Sugimoto	109460	6627

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

HO, THOMAS M

ART UNIT PAPER NUMBER

2134

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/853,708	Applicant(s) SUGIMOTO, TAKAHIRO	
	Examiner Thomas M. Ho	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12, 14-20, 22-24, 37-54, 57-67, 73-79 are pending.

Response to Arguments

2. Applicant has argued on page 24, 3rd paragraph that “the claims do not merely recite a security policy, but recite a method for establishing a security policy” Applicant has emphasized this distinction over the claiming of a mere security policy and further argues:

“However, even if a security policy is considered an abstract idea, the claims are directed to a practical application of establishing a security policy, not a security policy itself. Thus, at least the independent claims, produce a “useful, concrete and tangible” result”

The Examiner disagrees.

If a security policy were considered an abstract idea, then establishing the abstract idea would produce an intangible result. It would not produce a “useful, concrete, and tangible” result as the Applicant asserts.

The Examiner has determined that a security policy, is in fact understood by those in the art to be an abstract idea, merely a step in a process of providing a tangible application.

The “Computer Security Reference Book”, Jackson et al., 1992 has illustrated on page 199, Figure 20.1, that the Security policy is the first step in a long development path towards providing a working system, and that in between the steps of providing a working system, lie the steps of designing a security model, determining security requirements, developing a formal and functional specification, and performing intermediate stage development.

The Examiner contends that Applicant step of establishing a security policy is but one developmental step, and furthermore, typically the First developmental step, in building a working system.

“Computer Security Reference Book”, Jackson et al., 1992, Page 200, paragraph 1 states:

“The starting point for both paths is a generic security policy. This is a natural language description of the security principles and practices of the organization in which the system is going to be used”

Paragraph 3 states:

“In the informal development, the next step after the creation or adoption of a security policy is the statement of security requirements.”

Paragraph 4 states:

“Next will come the function specification,..”

Paragraph 6 states:

“Once validation of the specification against the requirements has taken place, the functional specification becomes the definitive description of the system to be implemented.”

From this, the Examiner contends that Applicant’s claims which recite the establishing of a security policy, are not claiming a tangible system, but rather one that has even yet to be implemented.

Furthermore, page 201, paragraph 3, recites that the next step of the development process, that is, the step after the establishing of a security policy is a security model. Paragraph 3 of page 201 recites:

“An alternative way of describing the security model is to say that it is a formal model of part of the security policy”

paragraph 7 of page 201 states simply:

“The security model will be quite abstract.”

“It may be a generic statement of the security policy that is yet to be implemented.”

Still furthermore, page 202. section 20.3.2 recites that:

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“A security model need not be a formalized mathematical model. Most are not. In the worst case, **a model is a conceptual model in someone’s head!**”

“The user will have his idea of what the security rules are, and the developer will have his own ideas, and they are unlikely to be the same.”

Still furthermore, page 202, section 20.3.2 paragraph 6 states:

“Security models are abstract, defining security properties and rules **without any consideration of the functioning of a machine or system on which they are to be implemented.**”

The Examiner will reiterate that the security model is the second step of the formal development path(Figure 20.1, page 199), and considered the “formal part of the security policy” page 201, paragraph 3.

In light of this evidence, it is the Examiner’s position that a security policy, and even the establishment of the security policy is an abstract idea and is thereby directed to non-statutory subject matter.

Further arguments are presented in the rejection under 35 USC § 101 below.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12, 14-20, 22-24, 37-54, 57-67, 73-79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2105 states

"The laws of nature, physical phenomena and abstract ideas" are not patentable subject matter.

The Examiner contends that Applicant's invention is an abstract idea. A security policy in itself, even if established (see below) is neither a process, machine, manufacture, nor composition of matter but is a common idea or concept shared among members of an organization.

The Examiner further holds Claims 1-12, 14-20, 22-24, 37-54, 57-67, 73-79 to be non-statutory because it neither produces a concrete, useful, nor tangible result. (all three requirements are necessary)

"For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See Alappat, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting Diamond v. Diehr, 450 U.S. at 192, 209 USPQ at 10). See also Alappat 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("unpatentability of the principle does not defeat patentability of its practical applications") (citing O 'Reilly v. Morse, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See AT &T, 172 F.3d at 1358, 50 USPQ2d at 1452." MPEP 2106 B(2)b(ii)

"The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application." MPEP 2601 Section II A

"A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459." MPEP 2601 Section II A

"A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness. In Sarkar, 588 F.2d at 1335, 200 USPQ at 139" MPEP 2106 B(2)b(ii)

Claims 1-12, 14-20, 22-24, 37-54, 57-67, 73-79 are further rejected under 35 U.S.C. 101 because the disclosed lacks utility.

In particular, while claims 59-67 recite a physical apparatus, the function of the physical apparatus is to establish a security policy, which in light of “Computer Security Reference Book”, Jackson et al., 1992 is but an abstract concept and a step, namely the first step, in producing a working system. Page 199, figure 20.1 As “Computer Security Reference Book” has stated(page 202, section 20.3.2), in the worst case, a security model, the formalized version of a security policy(page 201, paragraph 3 & page 199, Figure 20.1) exists only in someone’s head. Therefore, even a physical apparatus that produces a security policy, though tangible, does not satisfy the 35 USC 101 requirement for utility. As evidenced by “Computer Security Reference Book”, Jackson et al., 1992, it is the common understanding in the art that a security policy is an abstract construction, only the first step in producing a working system, and requires substantial formal and informal validation and verification before a working system can be derived from it.

For this reason it is the Examiner’s position that the results produced by the Claims 59-67, in view of the understanding of those skilled in the art, lack utility.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-12, 14-20, 22-24, 37-54, 57-67, 73-79 rejected under 35 U.S.C. 112, first paragraph.

Since the claimed invention is not supported by either an asserted utility consistent with the art or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Additionally, details or methods of analysis critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant's claims are a method of establishing a security policy. However the steps disclosed are deficient in that one of ordinary skill in the art would not be able to establish the security policy based on this disclosure. The Applicant has recited steps that depend on skill and responses of individuals within an organization and has a strong dependant basis on the merit of the individuals who provide the response. No technical guidance is presented in the claim as to how to create such a security policy.

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While the Applicant has amended the draft preparation step to further include details of how the draft is prepared, the disclosure still remains deficient because it fails to disclose the technical considerations that are crucial to development of the security policy.

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Conclusion

7. Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571)272-3838.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

General Information/Receptionist Telephone: 571-272-2100 Fax: 703-872-9306

Customer Service Representative Telephone: 571-272-2100 Fax: 703-872-9306

TMH

February 6th, 2006


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER